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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,772	04/13/2004	Sung-wook Park	1793.1236	3188

49455 7590 04/30/2008

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EXAMINER	
LEE, JINHEE J	

ART UNIT	PAPER NUMBER
2175	

MAIL DATE	DELIVERY MODE
04/30/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/822,772	PARK ET AL.	
	Examiner	Art Unit	
	Jinhee J. Lee	2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 March 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33,35 and 37-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33,35 and 37-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *0408*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in Korea on 8/16/03 and 2/3/04.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 35, 37-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites the limitation "the one interactive graphics stream being used to control reproduction of audio-visual data and being reproduced" in line 10-11. This is confusing. What is being reproduced? Clarify.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 33, 35, 37-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Re claims 33, 35, 37-40, claims 33, 35, 37-40 fails to fall within a statutory category of invention. They are directed to a program itself, not a process occurring as a result of executing the program, a machine programmed to operate in accordance

with the program nor a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. They are also clearly not directed to a composition of matter. Therefore, they are non-statutory under 32 USC 101.

The applicant discloses storage to include ROMs, RAMs, which are not physical devices. Claims 33, 35, 37-40 still do not refer to a tangible or physical product device.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 33, 35, 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Setogawa et al. (6246402).

Re claim 33, Setogawa et al. substantially discloses an information storage medium, comprising:

audiovisual (AV) data (see abstract for example);

navigation data that is a set of navigation commands related to reproduction of the AV data (see column 1 lines 12-14 according to the numbering in the middle for example); and

one or more interactive graphics streams which are used to control reproduction of audio-visual data and are reproduced with the audio-visual data (audio and/or video data and menu screen data, see column 2 lines 24-26 for example).

Setogawa et al. does not explicitly disclose wherein one interactive graphics stream among the one or more interactive graphics streams is selected by attribute information in a player status register in the reproducing apparatus.

However, Setogawa et al. teaches of dividing reproduction units for every attribute and status transition extracting means (for player status register for example) that extracts the status transition between the divided reproduction units and the grouped reproduction groups (see column 4 lines 27-32 for example). It would have been an obvious matter of design choice to have wherein one interactive graphics stream among the one or more interactive graphics streams is selected by attribute information in a player status register in the reproducing apparatus, since such a modification would have involved the mere application of a known technique (selecting by attribute information) to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one

known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 35 (as best understood), Setogawa et al. substantially discloses an apparatus comprising:

a processor (310 for example) which obtains attribute information (divides based on attributes, see column 37 lines 9-14 and lines 27-31 for example) in a player status register (microprocessor extracts status transition displayed) in the apparatus.

Setogawa et al. does not explicitly disclose a decoder which reads and reproduces one of the interactive graphics streams corresponding to the obtained attribute information from among the one or more interactive graphics streams from the information storage medium, the one interactive graphics stream being used to control reproduction of audio-visual data and being reproduced with the audio-visual data

However, Setogawa et al. teaches of a decoding circuit 222 used in the control portion 24 (see column15 lines 65-67 for example) for the reproduction of audio-visual

data. It would have been an obvious matter of design choice to have a decoder which reads and reproduces one of the interactive graphics streams corresponding to the obtained attribute information from among the one or more interactive graphics streams from the information storage medium, the one interactive graphics stream being used to control reproduction of audio-visual data and being reproduced with the audio-visual data, since such a modification would have involved the mere application of a known technique (using a decoder) to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 37, note that Setogawa et al. discloses an apparatus, wherein the processor executes a program object comprised of navigation commands that is related to the audio-visual data to enable selection of the one interactive graphics stream (see column 37 lines 37-41 for example).

Re claim 38, note that Setogawa et al. discloses an apparatus, wherein the processor loads and executes an interactive graphics stream change program included in the one interactive graphics stream that is being reproduced and reads and reproduces another interactive graphics stream selected according to new attribute information obtained by executing the interactive graphics stream change program (see column 37 lines 37-41 and lines 47-50 for example).

Re claim 39, note that Setogawa et al. discloses an apparatus, wherein the interactive graphics stream change program is a button command included in a button object (see column 35 lines 27-29 for example).

Re claim 40, note that Setogawa et al. discloses an apparatus, wherein the attribute information includes menu language information, viewer class information, sub-title language information, and audio language information (see column 37 lines 30-36 for example).

Response to Arguments

9. Applicant's arguments with respect to claims 33, 35, 37-40 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J. Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M-F at 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on 571-272-2100 ext. 75. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jinhee J Lee/
Primary Examiner, Art Unit 2174

jjl